

**REMARKS**

**I. Status of the Claims**

Claims 1-69 are currently pending in this application. Claims 14-21, 24-29, and 31-65 stand withdrawn from consideration as being drawn to non-elected subject matter.

Applicants respectfully remind the Examiner, if any of the elected species are found allowable, of her duty to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to a “reasonable” number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

Applicants respectfully acknowledge that the Examiner has withdrawn the rejection of claims 5 and 67 under 35 U.S.C. § 112, ¶ 2. See Office Action at 2.

**II. Rejection Under 35 U.S.C § 102(b)**

The Examiner rejects claims 1, 3, 4, 9-13, 22, 23, 66, and 69 under 35 U.S.C. § 102 (b) as anticipated by U.S. Patent Application Publication No. 2001/0054206 to Matsunaga et al. (“*Matsunaga*”) as evidenced by International Cosmetic Ingredient Dictionary and Handbook, Seventh Edition (1997), page 73 (“*Handbook*”). See Office Action at 2-4. Specifically, the Examiner asserts that *Matsunaga* teaches a composition comprising a fluorescent dye and Amodimethicone. See *id.* at 3. The Examiner alleges that, based on the *Handbook*, a skilled artisan would recognize that “‘Amodimethicone’ is an aminosilicone, used in hair dyes.” *Id.* Applicants traverse this rejection for at least the following reasons.

As has often been made clear by the Federal Circuit, anticipation requires that each and every claim limitation be met by a single reference. *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 U.S.P.Q.2d 1565, 1567 (Fed. Cir. 1995). Moreover, the reference must clearly and unequivocally disclose the claimed composition to one of ordinary skill in the art “without *any* need for picking, choosing and combining various disclosures.” *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972).

*Matsunaga* does not teach each and every element of the presently amended claims. Specifically, *Matsunaga* does not teach or suggest Applicants’ presently claimed fluorescent dyes. While the Examiner alleges that *Matsunaga* teaches the presently elected aminosilicone of formula (A), the Examiner does not allege that it teaches the presently elected fluorescent dyes, i.e., those of formula (F3). In fact, the Examiner has not rejected claim 6, which is specifically directed to compositions comprising the elected dyes, as being anticipated by *Matsunaga*. Therefore, *Matsunaga* does not teach every element of the present claims. In the absence of a sustainable *prima facie* case of anticipation, Applicants respectfully request that this rejection be withdrawn.

### **III. Rejections Under 35 U.S.C. § 103(a)**

#### **A. *Luo***

The Examiner rejects claims 1, 9-13, and 30 as unpatentable over WO 99/13846 to Luo et al. (“*Luo*”). See Office Action at 4-6. As in the previous Office Action, the Examiner continues to assert that *Luo* teaches fluorescent dyes. *Id.* at 5. The Examiner admits that *Luo* does not teach a fluorescent dye in combination with an

aminosilicone, but alleges that *Luo* “fairly suggest[s] an aminosilicone as the silicone compound, such that one skilled in the art would be able to select an aminosilicone compound from the list of silicone compounds taught as a matter of routine experimentation, with a reasonable expectation of success.” *Id.*

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; *see also* M.P.E.P. § 2141(II). It is important to note that in this evaluation the references must be considered in their entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *See* M.P.E.P. § 2141.02(VI) (citation omitted).

In addition, the Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” M.P.E.P. § 2142 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006)); *see also KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727,

1741, 82 U.S.P.Q.2d 1385, 1396 (quoting Federal Circuit statement with approval).

Applicants submit that such “articulated reasoning” is absent in the present case for at least the following reasons.

First, *Luo* contains no teaching, suggestion, or motivation for lightening dark hair with direct dyes. According to the general knowledge of those skilled in the art, it was not possible to lighten dark hair with the aid of direct dyes without the aid of oxidation agents. According to a recent review demonstrating the general knowledge of the skilled artisan, “[w]ith direct dyes, as opposed to oxidation dyes, the actual dye (and not its precursor) is applied to the hair. . . . **Lightening is not possible.**” See Ullman’s Encyclopedia, 2006 at 5.2.3 (emphasis added) (attached herewith). Nor does *Luo* provide any motivation for using direct dyes for lightening hair. Thus, there is no motivation for a skilled artisan based on *Luo* or the general knowledge in the art to employ direct dyes without the use of oxidation dyes to lighten dark hair.

Second, *Luo* does not teach or suggest every element of the claims, such as the presently elected fluorescent dyes, i.e., those of formula (F3). In fact, again, the Examiner has not rejected claim 6, which is specifically directed to compositions containing the elected dyes, as being rendered obvious by *Luo*. Therefore, *Luo* does not teach or suggest all elements of the present claims, such as the presently elected fluorescent dyes, let alone in combination with at least one aminosilicone.

In fact, as previously explained, *Luo* does not teach or suggest any dyes that absorb light in the visible spectrum and possibly in the ultraviolet spectrum, such as wavelengths ranging from about 360 to about 700 nm, and emit fluorescent light of a longer wavelength in the visible region of the spectrum, as the fluorescent dyes of the

present claims. See Specification at ¶¶ [020]-[021]. Rather, *Luo* teaches the use of silicones in combination with optical brighteners, which absorb light in the ultraviolet region with major absorption peaks ranging from about 200 to 400 nm, and emit light in the visible region of the spectrum. Even, assuming *arguendo*, that *Luo*'s vague reference to fluorescent brighteners suggested the use of fluorescent dyes in combination with silicone, nothing in *Luo* would teach or suggest the specific elected fluorescent dyes of the present claims. Thus, not only would a skilled artisan need to divine that aminosilicones could be used with certain dyes, but also that aminosilicones could be used in combination with the specific fluorescent dyes of the presently amended claims. Therefore, *Luo* does not teach, either explicitly or inherently, each and every limitation of the pending claims. Applicant respectfully requests withdrawal of this rejection and allowance of the pending claims.

**B. *Matsunaga* in view of *Peters***

The Examiner rejects claim 2 as unpatentable over *Matsunaga* in view of European Patent Application No. EP 370470 to Peters et al. ("*Peters*"). See Office Action at 6-7. The Examiner alleges that *Matsunaga* teaches a composition comprising a fluorescent dye known as Basic Yellow 2 and Amodimethicone. See *id.* The Examiner admits that *Matsunaga* does not teach a dye in the orange range, but alleges that *Peters* rectifies the deficiency by teaching yellow or orange fluorescent dyes that may be used with a silicone oil carrier. See *id.* at 7. The Examiner asserts that a skilled artisan would be motivated to combine the teachings of *Matsunaga* with *Peters* "because the dye provides an aesthetically pleasing appearance to the hair," and with a

reasonable expectation of success because “both references are drawn to dye compositions comprising a fluorescent dye and a silicone carrier.” *Id.*

Applicants respectfully disagree and traverse this rejection for at least the following reasons. There is no motivation to combine *Peters* and *Matsunaga*, and neither reference, alone or in combination, teaches or suggests all of the elements of the present claims.

First, the skilled artisan would not be motivated to combine the teachings of *Matsunaga* and *Peters* with any reasonable expectation of success. Neither *Peters* nor *Matsunaga* provides any motivation to use direct dyes for lightening dark hair. As discussed above, a skilled artisan would not be motivated to use direct dyes for lightening hair without the use of oxidation dyes. *Peters* and *Matsunaga* do not provide this motivation either. Moreover, *Peters*, unlike the present invention and *Matsunaga*, is not directed to hair dyes. Although *Peters* mentions application to the hair, there is absolutely no disclosure of a hair dyeing composition. The fluorescent dyes employed by *Peters* are not known to have any applicability to hair dyeing compositions. See *Peters*, col. 1, lines 35-36. In contrast, *Peters* contains numerous disclosures of other, non-permanent, cosmetic applications, such as “lipsticks, glosses, blush powders, mascaras and other similar make-up compositions.” *Id.* at col. 2, lines 23-26. Skilled artisans are well aware that the pigments for use in lipstick compositions, for example, will not necessarily perform well in hair dyeing applications. Accordingly, and contrary to the Examiner’s assertion, one of ordinary skill would have no motivation to combine the disclosures of *Peters* and *Matsunaga* with any expectation of success, and

Applicants assert that the Examiner should withdraw the rejection for at least this reason.

Second, *Peters* and *Matsunaga* do not teach each and every element of the pending claims. The Examiner admits that *Matsunaga* does not teach the dyes of claim 2, let alone those of formula (F3). *Peters* does not rectify this deficiency. In fact, *Peters* teaches the use of “daylight fluorescent” dyes, which “to date have not been utilized in cosmetic compositions.” See *Peters*, col. 1, lines 35-36. Thus, *Matsunaga* and *Peters* do not teach, either explicitly or inherently, each and every limitation of the pending claims. Applicant respectfully requests withdrawal of this rejection and allowance of the pending claim.

#### IV. Double Patenting Rejections

The Examiner rejects claims 1-13, 22, 23, 30, and 66-69 under the judicially-created doctrine of obviousness-type double patenting on six different grounds:

(1) claims 1-13, 22, 23, 30, and 66-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 and 39 of U.S. Patent No. 7,147,673 in view of the *Handbook*. See Office Action at 8.

(2) claims 1-13, 22, 23, 30, and 66-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-38 and 45 of U.S. Patent No. 7,186,278 in view of the *Handbook*. See *id.*

(3) claims 1-13, 22, 23, 30, and 66-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 and 31 of U.S. Patent No. 7,192,454 in view of the *Handbook*. *See id.*

(4) claims 1-13, 22, 23, 30, and 66-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 44-81 and 86 of U.S. Patent No. 7,198,650 in view of the *Handbook*. *See id.*

(5) claims 1-13, 22, 23, 30, and 66-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 and 37 of U.S. Patent No. 7,204,860 in view of the *Handbook*. *See id.*

(6) claims 1-13, 22, 23, 30, and 66-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-41 and 48 of U.S. Patent No. 7,208,018 in view of the *Handbook*. *See id.*

While Applicants respectfully traverse these rejections, in order to advance prosecution, Applicants submit herewith a Terminal Disclaimer to obviate these rejections. Accordingly, Applicants respectfully request the withdrawal of these rejections.

### **CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request reconsideration of the pending claims and their timely allowance.

If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, she is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4152.




Please grant any extensions of time required to enter this paper and charge the required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: October 8, 2008

By: \_\_\_\_\_

  
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**Attachments:** Ullman's Encyclopedia (2006); and  
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